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In re Application of
KITAMURA et al.
Application No.: 10/532,833
PCT No.: PCT/JP03/13653
Int. Filing Date: 24 October 2003
Priority Date: 28 October 2002
Attorney's Docket No.: 59216.1540
For: AN AUTOMATIC SHIFTING-
OPERATION CONTROL SYSTEM

DECISION ON
PETITION
UNDER 37 CFR 1.182

This is in response to applicant's "Petition to Correct Application Classification under 37 CFR 1.182", filed in the United States Patent and Trademark Office (USPTO) on 04 August 2005. Applicant requests that the above referenced application be converted from a national application filed under 35 U.S.C. 371 to an application filed under U.S.C. 111(a). A \$400.00 petition fee has been charged to applicant's deposit account per their authorization.

BACKGROUND

On 24 October 2003, applicant filed international application PCT/JP03/13653, which claimed priority of an earlier Japanese application filed 28 October 2002.

On 26 April 2005, applicant filed a transmittal letter requesting filing under 35 U.S.C. 371 in the United States which was accompanied by, *inter alia*, the basic national fee of \$300.

On 04 August 2005, applicants filed the instant petition to convert the national stage application, mistakenly filed under 35 U.S.C. 371, to an application filed under 35 U.S.C. 111(a).

DISCUSSION

Applicant submitted U.S. national application papers including an amended specification indicating the following : "This application is a continuation of PCT/JP03/13653 filed on October 24, 2003."

As explained at Section 1893.03(a) of the Manual of Patent Examining Procedure (MPEP), any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13

entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

The Transmittal Letter (Form PTO-1390) filed on 26 April 2005 identified the application as "a filing under 35 U.S.C. 371." The specification, filed on the same date, in the first line identifies the papers as a "continuation of PCT/JP03/13653 filed on October 24, 2003." The Transmittal Letter (Form-1390) used by applicant is to be used only with submissions under 35 U.S.C. 371. The Office provides the TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371 (FORM PTO-1390) so that applicants can comply with 37 CFR 1.495(g) and so that the Office's personnel can readily distinguish between submissions under 35 U.S.C. 371 and 35 U.S.C. 111(a). Applicants submitted the papers with the Transmittal Letter indicating that applicants were filing under 35 U.S.C. 371. The filing of the PTO-1390 is viewed by office personnel as a clear indication of papers submitted under 35 U.S.C. 371.

Nevertheless, applicants' reference to the papers as a continuation application in the specification is inconsistent with the Transmittal Letter filed 26 April 2005 and contradicts the request in the Transmittal Letter to file under 35 U.S.C. 371. A national application which requests treatment as a continuation of an earlier international application cannot be considered the national stage application of that international application, and under the present circumstances, the statement in the specification is an indication of papers filed under 35 U.S.C. 111(a).

In view of the above, it is proper to grant applicants' petition to treat the initial filing as a filing under 35 U.S.C. 111(a). The declaration filed on 26 April 2005 and the specification filed on 26 April 2005 met the requirements for granting a filing date for a filing under 35 U.S.C. 111(a). Accordingly, the petition to accept the papers as a filing under 35 U.S.C. 111(a) with an filing date of 26 April 2005 is **GRANTED**.

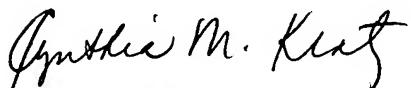
Applicants are entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 10/532,833) and the international application (PCT/JP03/13653) designating the United States were copending on 26 April 2005.

CONCLUSION

The petition under 37 CFR 1.182 to consider the papers filed on 26 April 2005 as a U.S. application filed under 35 U.S.C. 111(a) is **GRANTED**.

This application is being forwarded to the International Division for removal of the papers communicated from the International Bureau to the United States of America. The application will then be forwarded to Office of Initial Patent Examination (OIPE) for processing

as a regular national application under 35 U.S.C. 111(a) with a filing date of **26 April 2005**.



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